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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,054	01/26/2001	Richard A. Mallo	56147USA8A.002	7236

7590 06/30/2005

Attention: Yen Tong Florczak
Office of Intellectual Property Counsel
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St. Paul, MN 55133-3427

EXAMINER

FUBARA, BLESSING M

ART UNIT PAPER NUMBER

1618

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,054

Applicant(s)

MALLO ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner acknowledges receipt of amendment and remarks filed 03/09/05. Claims 29-43 are pending.

Claim Rejections - 35 USC § 101

The rejection of claims 13, 14 and 29-41 under 35 U.S.C. 101 for inconsistent utility of known composition is withdrawn in light of the amendment to the claims.

Claim Rejections - 35 USC § 112

1. The rejection of claims 13, 14 and 29-41 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is withdrawn in light of the amendment.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 29-39, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 3,941,733).

Chang teaches dispersions of poly (urethane-urea) terminated by hydrolysable or hydrolyzed silyl groups (abstract). The dispersion further comprises solubilizing groups, which are groups that ionize in water such as carboxyl, sulfate sulfonate, phosphonate and quaternary ammonium compounds (column 3, lines 1-6). Isocyanate, specifically diisocyanate, polymeric polyol, silyl compound, e.g. X₃Si-compound, ethylene glycol polyfunctional chain extender, and water solubilizing compound react to form polyurethane-urea dispersions in water (column 3, line 14 to column 4, line 4 and column 6, lines 26-31). Terminal silyl groups are listed in column 7, lines 1 1-25 and all but one are clearly the silyl groups recited in claim 7 of the instant

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invention. Ammonium carboxylates are disclosed as water-soluble thermoplastic compounds (column 7, lines 49-65).

The composition used in the method of the instant claims is a known composition as discussed above for Chang. However, Chang does not use the composition for the instant method. The claiming of a new use, new function or unknown property, which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 MPEP § 2141.02

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to film coat surfaces with the composition of Chang. One having ordinary skill in the art would have been motivated to do so with the expectation of coating surfaces with the composition. And the claiming of a new use or property for known composition does not make the new use or property patentable over the prior art.

4. Claims 29-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 3,941,733) and Gaa et al. (US 4,567,228).

Chang discloses a composition that comprises polyurethane urea that is functionalized with silyl group. Chang does not disclose that the composition contains pigments or surfactants, plasticizers, antioxidants, fillers and other additives. However, Gaa discloses a coating composition that comprises polyurethane urea that is functionalized with silyl group and pigments, surfactants, plasticizers, antioxidants, fillers or other additives. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the composition of Chang and use it to coat surfaces. One having ordinary skill in the art would have been motivated to modify the composition of Chang by including the additives of

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Gaa with the expectation that composition containing the plasticizers/additives would coat the surfaces.

The claiming of a new use, new function or unknown property, which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 MPEP § 2141.02

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roesler et al. (US 5,932,652) discloses aqueous dispersion of polyurethane-urea and the polyurethane-urea has alkoxysilane groups; the aqueous dispersions are used to coat surfaces (abstract; column 1, line 59 to column 9 line 32.

Joh (US 4,872,867) discloses blood contact antithrombogenic medical devices that contain antithrombogenic elastomer that is formed from polyurethane-urea base component and cross-linking polysiloxane (abstract; column 1, line 64 to column 6 line 68.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594.

The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
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